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09/706,753	11/07/2000	Tsutomu Tanaka	2000-1536A	5990

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EXAMINER

LONSBERRY, HUNTER B

ART UNIT PAPER NUMBER

2623

DATE MAILED: 05/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/706,753

Applicant(s)

TANAKA ET AL.

Examiner

Hunter B. Lonsberry

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 46-71 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 46,47,54,61-67 and 71 is/are rejected.
- 7) ☒ Claim(s) 48-53,55-60 and 68-70 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 46-47, 54, 61-67 and 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,029,045 to Picco in view of U.S. Patent 5,929,849 to Kikinis.

Regarding claim 46, Picco discloses in figure 7, a terminal 120 for receiving and outputting a transmitted video content (column 11, lines 18-column 12, line 58), said terminal comprising:

a reception unit 180 operable to receive the video content containing tag information (local content signal 108) which corresponds to the video content, which is used to select a plurality of Commercial messages (column 6, line 1-41), and which indicates a correspondence between the video content and the plurality of Commercial messages (column 6, line 1-41, line 57-column 7, line 33, line 50-column 8, line 17,

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column 9, line 61-column 10, line 29 , a scheduler determines which local content is going to be combined with the corresponding live video feed)

a commercial specifying unit 188 (column 11, lines 35-54) operable to specify the at least one of the plurality of Commercial messages based on location information indicating an area where said terminal is located and the tag information (column 7, lines 3-33, 54-column 8, line 22);

a fetch unit 188 operable to fetch the at least one of the plurality of Commercial messages (column 11, lines 35-54); and

an output unit (splicers 190/192) operable to output the video content and the at least one of the plurality of Commercial messages which corresponds to the video content (column 11, lines 35-column 12, line 30).

Picco fails to disclose the use of commercial messages ,which are each assigned a URL, a URL specifying unit, fetching the commercial message by using the URL, however Picco does disclose web browsing, and that the system may be used to connect to the Internet to provide targeted commercials (column 13, lines 24-26, column 14, lines 58-67).

In an analogous art, Kikinis discloses a combination television/web system in which one or more tagged video streams are transmitted to a user and contain URLs (column 6, line 33-column 7, line 18), these URLs may be transmitted in advance, and allow the STB to use the URL to access the Internet and download the corresponding web content (column 9, line 9-column 10, line 40), the content referenced by the URL

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may provide a user with more information regarding the commercial, or other program content (column 9, lines 4-23).

Therefore, it would have been obvious to one skilled in the art at the time of invention to modify Picco to utilize the URLs and fetching capabilities of Kikinis for the advantage of enabling a user to learn more about a program or advertisement, which they have viewed.

Regarding claim 47, Picco discloses that tag information is read, and utilized in conjunction with a profile to determine a correspondence between the tag information and location information (column 7, lines 3-33, 54-column 8, line 22).

Kikinis is relied upon to teach the use of a URL associated with one of a plurality of commercial messages.

Regarding claim 54, Picco discloses the use of a name server (scheduler148 and agent 150) which determines which local content is going to be combined with the live video, this data is sent out as tag data to the STB which determines based upon the area in which the terminal is located, the video content itself, which commercial messages to store in the STB (column 6, line 1-41, line 57-column 7, line 33, line 50-column 8, line 17, column 9, line 61-column 10, line 29).

Kikinis is relied upon to teach the use of a URL associated with one of a plurality of commercial messages.

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Regarding claim 61, Picco discloses a storage device 186 for storing the plurality of commercial messages (column 11, lines 35-48), and outputting the video content containing the tag information corresponding to the video content and plurality of commercial messages corresponding to the video content (column 11, line 49-column 12, line 58),

When a user decides to browse the web, the television programming is stored locally, when the user finishes browsing the corresponding programming data is outputted from storage to the user (figure 11).

Regarding claim 62, Kikinis is relied upon to teach tag information, which includes the name of the sponsor (www.bmw.com, column 7, lines1-17).

Regarding claim 63, Picco discloses in figure 7, a content providing system for providing video content and one of a plurality of commercial messages corresponding to the video content (column 11, lines 18-column 12, line 58), said system comprising:

A transmitting device 102 for transmitting the video content containing tag information including information of the video content (column 6, line 1-41, line 57-column 7, line 33, line 50-column 8, line 17, column 9, line 61-column 10, line 29)

A storage device 186 for storing the plurality of commercial messages (column 11, lines 35-48),

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A terminal 120 for specifying the plurality of commercial messages column 12, lines 37-58), establishing a correspondence between the video content and plural commercial messages (column 6, line 1-41, line 57-column 7, line 33, line 50-column 8, line 17, column 9, line 61-column 10, line 29 , a scheduler determines which local content is going to be combined with the corresponding live video feed in conjunction with profile information) and outputting the video content containing the tag information corresponding to the video content and plurality of commercial messages corresponding to the video content (column 11, line 49-column 12, line 58).

Picco fails to disclose the use of commercial messages ,which are each assigned a URL, however Picco does disclose web browsing, and that the system may be used to connect to the Internet to provide targeted commercials (column 13, lines 24-26, column 14, lines 58-67).

In an analogous art, Kikinis discloses a combination television/web system in which one or more tagged video streams are transmitted to a user and contain URLs (column 6, line 33-column 7, line 18), these URLs may be transmitted in advance, and allow the STB to use the URL to access the Internet and download the corresponding web content (column 9, line 9-column 10, line 40), the content referenced by the URL may provide a user with more information regarding the commercial, or other program content (column 9, lines 4-23).

Therefore, it would have been obvious to one skilled in the art at the time of invention to modify Picco to utilize the URLs of Kikinis for the advantage of enabling a user to learn more about a program or advertisement, which they have viewed.

Regarding claim 64, Picco discloses that tag information is read, and utilized in conjunction with a profile to determine a correspondence between the tag information and location information (column 7, lines 3-33, 54-column 8, line 22).

Kikinis is relied upon to teach the use of a URL associated with one of a plurality of commercial messages.

Regarding claim 65, Picco discloses the use of a name server (scheduler 148 and agent 150) which determines which local content is going to be combined with the live video, this data is sent out as tag data to the STB which determines based upon the area in which the terminal is located, the video content itself, which commercial messages to store in the STB (column 6, line 1-41, line 57-column 7, line 33, line 50-column 8, line 17, column 9, line 61-column 10, line 29).

Kikinis is relied upon to teach the use of a URL associated with one of a plurality of commercial messages.

Regarding claims 66-67, Picco discloses that an output time for each of the plurality of commercial messages is determined (column 6, line 56-column 7, line 3),

And when the tag information is embedded in the video content, the transmitting device is operable to separately embed the tag information according to respectively predetermined output time of each of the plurality of commercial messages so that the

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terminal is able to obtain each of the plurality of commercial messages before the output time there of (column 7, line 55-column 8, line 36).

Regarding claim 71, Kikinis is relied upon to teach tag information, which includes the name of the sponsor (www.bmw.com, column 7, lines 1-17).

Allowable Subject Matter

3. Claims 48-53, 55-60 and 68-70 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record does not disclose nor reasonably suggest the terminal of claim 48 nor system of claim 68, in which at least a portion of the video content is scrambled, and at least one of the plurality of commercial messages, which is specified by a URL, contains a key, which is utilized to descramble the video content. The Examiner notes that this requires retrieving the commercial message prior to the display of the video content, that is to say that at least a portion of both the video message and commercial must be retrieved and processed prior to any display and is fully supported by Applicant's specification.

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hunter B. Lonsberry whose telephone number is 571-272-7298. The examiner can normally be reached on Monday-Friday during normal business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



HBL Patent Examiner
AU 2623